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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,174	12/05/2001	William Gobush	20002.0162	3740

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SWIDLER BERLIN SHEREFF FRIEDMAN, LLP
3000 K STREET, NW
BOX IP
WASHINGTON, DC 20007

EXAMINER

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,174

Applicant(s)

GOBUSH ET AL.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed on March 4, 2004 has been received and considered. By this amendment, claims 36-37 have been added, and claims 1-35 are now pending in the application.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36-37 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the claimed limitation does not have any connection with other limitations.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321[©] may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 7-8, and 12 of U.S. Patent No. 6,758,759.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 18, 28, and 36-37 of the present application basically teach the same inventive subject matter of claims 1, 3, 7-8, and 12 of the patent '759 in broader scope by replacing the camera with a light receiver. Further, other dependent claims of the present application such as choosing a specific primary emission wavelength, a specific low pass filter wavelength, etc. would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1- 10, 28-29, 31-33, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naoi et al (US patent No. 5,459,793).

a. As per claim 1, Naoi discloses a portable monitor system for measuring kinematics of an object comprising a light source capable of directing light at an object, and a light receiver (abstract). Naoi does not explicitly disclose including a fluorescent marker in the object and a filter in the light receiver. However, since Naoi discloses choosing a marker with a high directivity light reflection member (col. 4, lines 9-13), and since it would have been well known that the fluorescent material generates high reflection, Naoi obviously encompasses teaching the well known high reflection fluorescent material. Further, Naoi discloses filtering color image (col. 3, lines 38-43). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the filter into the receiver in order to facilitate filtering a particular frequency of the light received at the receiver.

b. As per claim 2, selecting a specific emission wavelength to observe requires only routine skill in the art.

c. As per claim 3-8 and 10, using a low pass filter or a band pass filter for filtering a range of frequency light would have been well known to a person of ordinary skill in the art at the time the invention was made. Further, filtering a specific range of frequency and selecting a light source with specific emission spectrum with a specific range of transmission wavelength as needed by a particular application would have been obvious and design choice.

d. As per claim 9, the electronically switchable filter is a well-known filter type.

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e. As per claim 28-29, 31-33, and 36-37, refer to discussion in claims 1, 8, 4 and 6 above.

6. Claims 11-27, 30, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naoi et al (US patent No. 5,459,793) in view of Gobush et al (US patent No. 5,575,719).

a. As per claim 11-12, Gobush discloses a strobe light source (col. 5, lines 15-18). Further, using light emitting diode as a light source would have been well known to a person of ordinary skill in the art at the time the invention was made.

b. As per claim 13, Gobush discloses including another object having a marker (col. 5, lines 10-13). Gobush does not disclose using marker of different reflective wavelength, size, etc. for the other object. However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to select a specific marker with specific reflective wavelength, size, etc. in order to facilitate tracking a specific object and excluding the object that the user is not interested in tracking the object.

c. As per claim 14, Gobush discloses a golf ball object (col. 3, lines 15-18).

d. As per claim 15, using an orange-fluorescent marker would have been well known to a person of ordinary skill in the art at the time the invention was made.

e. As per claim 16-17, Gobush discloses including a central processing unit 5 in the system (Fig. 4). Further, designing a system with a specific weight to fit a specific application requires only routine skill in the art. Further, using a battery as a power source would have been well known to a person of ordinary skill in the art at the time the invention was made.

f. As per claim 18-27, 30, and 34-35, refer to discussion in claims 1, 3-4, 6-11, and 13 above.

Response to Arguments

7. Applicant's arguments filed on March 4, 2004 have been considered but are moot in view of the new ground of rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action. Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Hand-delivered responses should be brought to Crystal Plaza II, Arlington, VA
Second Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The
examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 308-1148.



Kim Nguyen
Primary Examiner
Art Unit 3713

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Date: August 5, 2004